

## **REMARKS**

This response is submitted in response to the Final Office Action mailed January 26, 2005, to request reconsideration of the rejection of claims 1-20 as set forth therein. In the event the Examiner determines that the foregoing amendments do not place the case in condition for allowance, it is respectfully requested that the above amendments be entered to place the claims in better form for consideration on appeal.

Claims 1-20 are pending, with the independent claims being claims 1, 5, 6, 13 and 14.

Claim 1 has been amended to correct a minor error by replacing "medical device" with "treatment equipment." Claims 13-16 are also amended to correct a minor error by replacing "medical" equipment with "treatment" equipment for consistency. Claim 13 and 14 are also amended to clarify which treatment equipment is being referred to. The amendment is fully supported in the original disclosure and does not materially change the scope of the claims or require a significant reconsideration by the Examiner. Entry of the amended claim is therefore believed to be appropriate and is respectfully requested.

Applicant presents further arguments clarifying how the pending claims are patentable over the cited references.

Claims 1, 2, 5 and 13-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,788,688 to Bauer et al.

In response, the Applicant respectfully traverses the Examiner's rejection of claims 1, 2, 5, and 13-20 under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Claim 1 sets forth a surgery system in which medical devices that drive associated treatment equipment communicate with one another. A given medical device

receives driving control information transmitted from another medical device and makes a permission/non-permission determination regarding whether or not operations can be made in synchronization with the other medical devices. Furthermore, the given medical device replies to the originating medical device with the permission/non-permission determination. Additionally, a driving control decision means at the originating medical device decides a driving control of the treatment equipment to which it belongs, based on the reply.

The Examiner asserts that Bauer et al. provides permission/non-permission decisions by a host computer instead of by medical devices, and that this is a matter of obvious design choice. In support, the Examiner cites the disclosure by Bauer et al. in which monopolar and bipolar devices are not allowed to operate simultaneously, referring to col. 16, lines 1-6. However, a close inspection of Bauer et al. indicates that Fig. 15A provides a first flowchart that represents logic in the surgeon's command and control (SCC) panel, and a second flowchart that represents a software process within particular pieces of specific surgical equipment, in this case the monopolar and bipolar electrosurgical devices (col. 14, lines 50-63, col. 15, lines 64-67). Thus, the decision of whether the monopolar or bipolar electrosurgical device should be turned on or off is carried out locally by the device itself based on information indicating whether a related command has been entered by the surgeon on a control panel (col. 16, lines 6-17).

However, there is no disclosure or suggestion by Bauer et al. that this decision is provided to any other medical device for use in deciding a driving control of the treatment equipment of the any other medical device. Applicant's approach is more advantageous since a given medical device can receive permission/non-permission decisions from a number of other medical devices for use in deciding a driving control of its treatment equipment in a

more sophisticated way. See also the advantages explained in the specification, page 42, last paragraph. Bauer et al. simply fails to disclose or suggest a surgery system that achieves these advantages. Regarding the Examiner's assertion that Applicant's Figure 8 supports the contention that Applicant's system is an obvious design variation of Bauer et al., Applicant notes that his application is not prior art and cannot be used to provide the motivation to modify a reference. MPEP 2143.01.

Accordingly, claim 1 and dependent claim 2 are clearly patentable over Bauer et al. Independent claim 5 is analogous to claim 1 but refers to transmitting switch data of one originating medical device to other medical devices, and is similarly patentable over Bauer et al.

Regarding claim 13, the same differs from claim 1 at least in that it sets forth that a second communication unit of a second medical device receives information from a first communication unit of a medical device regarding the type of connected equipment of the first medical device. Furthermore, a decision unit of the second communication unit makes a permission/non-permission determination based on the conveyed information regarding the type of the connected treatment equipment of the first medical device.

The Examiner does not appear to address this feature, in particular, and merely asserts that the processor of a computer system can send any information or control signals to the devices of Bauer et al. However, this assertion is insufficient to establish a *prima facie* case of obviousness. In particular, one cannot base obviousness upon what a person skilled in the art could or might try but rather must consider what the prior art would have led a person skilled in the art to do. In re Antonie, 559 F.2d 618 195 USPQ 6 (CCPA, 1977). The Examiner must make a showing of a suggestion or motivation in the art to combine the

references. In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). See also MPEP 2143.01. The Examiner has failed to make such a showing. Thus, Applicant submits that the rejection is improper and should be withdrawn.

Specifically, Applicant respectfully submits there is simply no disclosure or suggestion by Bauer et al. of having medical devices convey information to one another regarding a type of a connected treatment device, and to act on this information by making a permission/non-permission determination as claimed.

Accordingly, claim 13 is clearly patentable over Bauer et al.

Claim 14 is similar to claim 13 but further sets forth that a decision unit of the first communication unit makes a permission/non-permission determination based on conveyed information regarding the type of the connected treatment equipment of the second medical device. Claim 14 is therefore clearly patentable over Bauer et al. for the above-mentioned reasons.

With regard to the rejection of claims 1, 2, 5 and 13-20 under 35 U.S.C. § 103(a), Independent claims 1, 5, 13, and 14, are not rendered obvious by the cited reference because the Bauer et al. patent whether taken alone or in combination with the knowledge of those of ordinary skill in the art, does not teach or suggest a surgery system having the features discussed above. Accordingly, claims 1, 5, 13 and 14 patentably distinguish over the prior art and are allowable. Claims 2 and 15-20, being dependent upon claims 1, 13, and 14, are thus allowable therewith. Consequently, the Examiner is respectfully requested to withdraw the rejection of claims 1, 2, 5 and 13-20 under 35 U.S.C. § 103(a).

Claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. in view of U.S. Patent No. 5,502,726 issued to Fischer. In

response, the Applicant respectfully traverses the Examiner's rejection of claims 3 and 4 under 35 U.S.C. § 103(a) for at least the reasons set forth below.

Since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 3 and 4 are at least allowable therewith because they depend from an allowable base claim.

Furthermore, the Applicant respectfully submits that claims 3 and 4 patentably distinguish over the cited references independently of their base claim. Fischer provides a network system for allowing remote medical instruments to communicate data to a central computer (col. 1, lines 26-28). However, there is no motivation to modify Bauer et al. in view of Fischer because Bauer et al. has no need for, and does not contemplate, such remote communications.

Still further, the Examiner asserts that the use of a watchdog timer 526 (Fig. 5) by Fischer renders claims 3 and 4 obvious. Applicant notes that the timer 526 in Fischer is only used to provide a reset signal to a workstation. In contrast, claim 3 recites structure for stopping the driving control of a medical device when driving control information transmitted from the driving control information transmission means of an originating medical device at constant intervals is not received within a stipulated time period. The stopping of the driving of a medical device as claimed by Applicant is not believed to be analogous to resetting a workstation that is remote from a medical instrument as provided by Fischer. Accordingly, claim 3 is clearly patentable over the combination of Bauer et al. and Fischer.

Furthermore, claim 4 sets forth that the driving control information of claim 3 is switch data indicating that an operating switch connected to the originating medical device has been switched on or off. Thus, the stopping of the driving control of a medical device

occurs when such switch data is not received within a stipulated time period. The cited references simply fail to disclose or suggest this feature, and the Examiner has not pointed out any portion of the cited references that supposedly teach this feature. Accordingly, claim 4 is clearly patentable over Bauer et al. and Fischer.

In view of the above, the Examiner is respectfully requested to withdraw the rejection of claims 3 and 4 under 35 U.S.C. § 103(a).

Claims 6-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer et al. in view of U.S. Patent No. 6,679,875 issued to Honda et al. In response, the Applicant respectfully traverses the Examiner's rejection of claims 6-12 under 35 U.S.C. § 103(a) for at least the reasons set forth below.

With regard to claims 8-12, the Applicant respectfully submits that since independent claim 1 patentably distinguishes over the prior art and is allowable, claims 8-12 are at least allowable therewith because they depend from an allowable base claim.

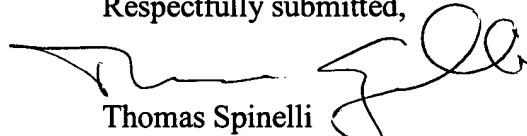
With regard to claims 6 and 7 and further with regard to claims 8-12, the Applicant notes that the present invention, app. no. 10/616,287, was commonly-owned with the subject matter of app. no. 10/074,381, which matured into U.S. patent 6,679,875 to Honda et al., by Olympus Optical Co., Ltd. at the time the present invention was made. This is documented by the U.S. Patent and Trademark Office Notice of Recordation of Assignment recorded July 9, 2003 for app. no. 10/616,287 at Reel 014272, Frame 0447 and by the Recordation of Assignment recorded February 12, 2002 for app. no. 10/074,381 at Reel 012592, Frame 0852. See also the enclosed STATEMENT OF COMMON OWNERSHIP TO DISQUALIFY A REFERENCE UNDER 35 USC § 103(c).

It is also noted that both applications were subsequently re-assigned to "Olympus Corporation" due to a corporate name change.

Therefore, under the provisions of 35 U.S.C. § 103(c), the Applicant respectfully requests that the Examiner remove U.S. patent 6,679,875 to Honda et al. as a reference under 35 U.S.C. § 103(a), and withdraw the rejection of claims 6-12 under 35 U.S.C. § 103(a).

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

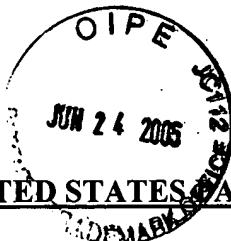
Respectfully submitted,



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Enclosure (STATEMENT OF COMMON OWNERSHIP)



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Applicant:** Hiroyuki Takahashi                      **Examiner:** Henry M. Johnson III  
**Serial No:** 10/616,287                                  **Art Unit:** 3739  
**Filed:** July 9, 2003                                      **Docket:** 16816  
**For:** INTEGRATED SURGICAL                      **Dated:** June 22, 2005  
              SYSTEM WITH MULTIPLE  
              DEVICES  
**Conf. No.:** 9906

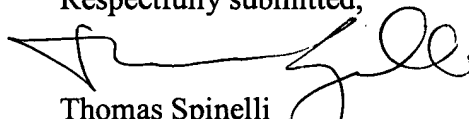
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Alexandria, VA 22313-1450

**STATEMENT OF COMMON OWNERSHIP TO DISQUALIFY**  
**A REFERENCE UNDER 35 U.S.C. § 103(c)**

Sir:

The Undersigned hereby states that both the instant application, U.S. Application Serial No. 10/616,287 and U.S. Patent No. 6,679,875 to Honda et al. were, at the time the invention of the instant application was made, owned by or subject to an obligation of assignment to Olympus Optical Co. Ltd.

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